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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,432	05/11/2001	Grace Wong	49853 (72024)	7247

7590 10/31/2002  
PETER F. CORLESS  
EDWARDS AND ANGELL, LLP  
P.O.BOX 9169  
BOSTON, MA 02209

EXAMINER

LI, RUIXIANG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/31/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/854,432

Applicant(s)

WONG, GRACE

Examiner

Ruixiang Li

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **I. Status of Application, Amendments, and/or Claims**

The amendment filed in Paper No. 8 on September 17, 2002 has been entered in full. Claims 1-3 have been amended. Claims 1-3 are pending. Claims 1 and 3 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### **II. Withdrawn Objections and/or Rejections**

The objection of claims 1 and 3 for minor informalities, as set forth at page 4 of the previous Office Action (Paper No. 7, June 17, 2002), has been withdrawn in view of applicants' amendment of the claims.

The rejection of claims 1 and 3 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as set forth at page 4 of the previous Office Action (Paper No. 7, June 17, 2002), has been withdrawn in view of applicants' amendment of the claims.

### **III. Objection to the Disclosure**

The objection to the disclosure, as set forth at pages 2 and 3 of the previous Office Action (Paper No. 7, June 17, 2002), remains.

Applicant argues that the gene sequences referred in the tables are not essential for the present invention. This has been fully considered but is not deemed to be persuasive because the sequences are needed to practice the instantly claimed

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invention, for example, to design probes. Without the gene sequence information, one skilled in the art would not be able to use the invention. The attempt to incorporate subject matter into this application by reference to a commercial sequence database is improper because such a database is subject to change and correction. It is imperative that the sequence as it was known at the time of filing is disclosed in the specification.

#### **IV. Claim Rejections Under 35 U. S. C. § 112, 1<sup>st</sup> Paragraph**

The rejection of claims 1 and 3 under 35 U. S. C. § 112, 1<sup>st</sup> paragraph, as set forth at pages 3 and 4 of the previous Office Action (Paper No. 7, June 17, 2002), remains.

Applicant argue that the sequences of the identified genes are not essential to practice the claimed invention and that the present invention does not relate to a particular set of differentially expressed genes following stimulation with tissue necrosis factor and interferon. This has been fully considered but is not deemed to be persuasive for the following reasons, as well as for the reasons set forth in the previous Office Action (Paper No. 7, June 17, 2002).

First, the claim amendment, while overcoming the rejection under 35 U.S.C. 112, 2<sup>nd</sup> Paragraph, set forth at page 4 of the previous Office Action (Paper No. 7, June 17, 2002), serves to broaden the claims. The specification does not enable measurement of any TNF and IFN stimulated genes other than those disclosed in the tables.

Second, reference to a commercial sequence database in table by the accession number is improper because such a database is subject to change and correction (and a gene sequence may be changed without changing the accession number).

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Furthermore, the specification does not enable the claimed method even for the genes listed in the tables, because one skilled in the art would need the sequences in order to design probes, for example, to use the claimed method to measure expression levels of the genes.

Therefore, It is imperative that the sequence as it was known at the time of filing is disclosed in the specification.

#### **V. Conclusion**

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (703) 306-0282. The examiner can normally be reached on Monday-Friday, 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Ruixiang Li  
Examiner  
October 29, 2002

*Elizabeth C. Lemmon*

ELIZABETH C. LEMMON  
PRIMARY EXAMINER